

### REMARKS

This paper is responsive to the Examiner's Supplemental Answer mailed on December 9, 2008, which contained rejections under 35 U.S.C. § 101 designated as ***new grounds of rejection***. That Supplemental Answer followed a Remand, mailed December 1, 2008, from the Board of Patent Appeals and Interferences. This paper constitutes a reply under 37 C.F.R. § 1.111 and is relevant to the new grounds of rejection. Entry of this reply and reconsideration the rejections made are both proper and required. 37 C.F.R. § 41.39(b)(1).

### Preliminaries

Upon entry of the present reply, present application returns to the Examining Corps for further examination. Applicant's responses to outstanding rejections under 35 U.S.C. § 103 (which are necessarily based on attributing to US Patent Application Publication 2002/0046064 an earlier effective reference date under Sections 119(e) and 102(e) of the statute) are part of the present record of replies and briefing. In accord with 37 C.F.R. § 41.39(b)(1), the remarks presented here pertain to the ***new grounds*** of rejection designated as such in Examiner's Supplemental Answer. Nonetheless, for completeness, and in view of the extended pendency of this matter, for avoidance of doubt, Applicant incorporates by reference the Arguments presented in the Appeal Brief, filed September 21, 2006, and the Reply Brief, filed March 19, 2007.

Also for avoidance of doubt, Applicant maintains its request that the Office provide evidence to support its apparent view that the claimed limitation of an actuary-manipulable representation of a rating model including variables, factor tables and calculation sequences ..., and more particularly a representation in which "factor tables hav[e] one or more axes bound to respective ones of the variables and the calculation sequences [are] defined in terms of steps operative on values of the variables and cells of the factor tables" is "well known in the art" as it pertains to an actuary manipulable representation of a rating model suitable for transformation (as claimed) into an executable form. Prosecution is now re-opened and it is now proper for the Office to provide some *evidence* to support that assertion.

We now turn to the new grounds of rejection.

New Grounds of Rejection—35 U.S.C. § 101

Claims 3-15, 19-21 and 24 all stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. These rejections have been made subsequent to the Federal Circuit's *en banc* decision in *In re Bilski*, which applied a "machine-or-transformation" test to the determination of patent eligibility of a process under § 101. In short, the Office now takes the position that present claims insufficiently recite the statutory nature of an apparatus that performs the recited method steps and/or insufficiently tie process steps to transformation of subject matter that is otherwise statutory.

Although Applicants believe that sufficient ties are already recited in the claims, in the interest of advancing prosecution, amendments have been made to unambiguously establish requisite ties to either or both of (i) a statutory "machine" that performs method steps and (ii) the *functional* material encoded in computer readable media (so as to establish same as statutory "articles") which constitutes the material transformed from one state or thing to another. In particular, relative to the method claims, amendments have been made to recite ties to both a machine and the statutory articles so transformed. Relative to the computer program product claims, amendments have been made to recite statutory physical structure in which actuary-manipulable and/or machine executable functional encodings reside. Finally, to establish an appropriate range of protection, new claims 25-27, directed specifically to statutory computational machines are added.

No new matter is added. Further examination and allowance are respectfully requested.

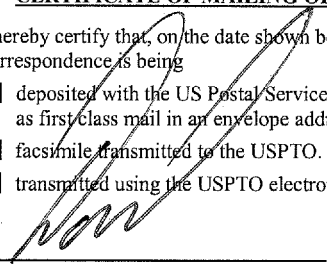
Conclusion

In summary, claims 3-15, 19-21 and 24-27 are in the case. Claims previously withdrawn based on restriction (i.e., claims 1, 2 and 16-18) have been cancelled without prejudice or disclaimer. All claims are believed to be statutory and allowable over the art of record, and a Notice of Allowance to that effect is respectfully solicited. Nonetheless, if any issues remain that could be more efficiently handled by telephone, the Examiner is requested to call the undersigned at the number listed below.

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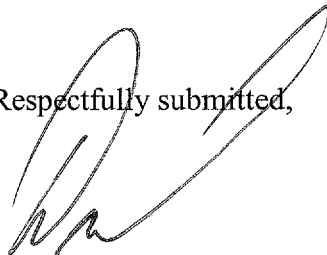
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David W. O'Brien

  
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Respectfully submitted,



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